

## **REMARKS/ARGUMENTS**

### **I. General Remarks**

Please consider the application in view of the following remarks.

### **II. Disposition of Claims**

Claims 1-35 are pending in this application.

Claims 16 is amended. This amendment was made to remove a claim number that Applicants changed by amendment in response to the previous office action.

### **IV. Allowable Claims**

Applicants acknowledge with appreciation that the Examiner has advised that claims 2-5, 9-12 and 29-35 are allowable over the art of record.

### **V. Claim Objections**

The Examiner has objected to claims 16-20, 22, 25 because of an informality in claim 16. That claim 16 was previously amended in response to the previous office action to change it from a claim dependent on claim 14 to an independent claim. Indication of deletion of the reference to claim 14 in claim 16 as amended in that previous response by a single strike-through was ineffective because of the appearance of the number "4." A double strike-through is being used in the amendment herein to remove the now extraneous "14." With this correction of the informality, claim 16 and claims 17-20, 22 and 25 dependent on claim 16 are now also believed to be in acceptable or unobjectionable form.

### **VI. Rejection of Claims under 35 U.S.C. § 102**

The Examiner has maintained his rejection of claim 28 under 35 U.S.C. 102(b) as being anticipated by Dymond (4777200).

The Examiner has stated that:

Dymond teaches an invert emulsion drilling fluid within the scope of the present invention, which comprises polymers such as 2-ethylhexyl acrylate and acrylic acid copolymer (see the examples and in particular example 3). The specified mineral oils used are synthetic, and contain paraffins and olefins. Since the fluids may be used as drilling fluids, the use of “consisting essentially of” cannot distinguish.

Applicants respectfully traverse this rejection. Applicants respectfully submit that mineral oil is a “traditional” oil for drilling fluids and not an oil commonly referred to in the oil industry as a “synthetic.” Applicants note the teaching of “traditional oil” in Dymond at paragraph [0024] of their specification. Moreover, Applicants clearly indicate in paragraph [0027] of their specification that “mineral oil” is not a “synthetic fluid” as that term is used in the present patent application.

Further, Dymond discloses thickeners with multiple uses. Every example of use in a drilling fluid employs a fluid having, among other components, a fluid loss control agent in the drilling fluid. Applicants’ independent claims 1, 14 and 27, as currently amended, specifically negate addition or inclusion of a fluid loss control agent. This distinction alone should be sufficient to distinguish Dymond as an anticipatory reference, as Dymond fails to have identity with each element in Applicants’ claims as required for anticipation.

Moreover, Applicants provided data distinguishing Dymond in Applicants’ specification. This data alone should be sufficient to rebut a finding of anticipation by Dymond. See Ex parte Skinner, 2 U.S.P.Q. 2d 1788 (B.P.A.I. 1986). However, the Examiner indicated in interview (see interview summary previously filed) that he believed that a broad range of fluid loss agents could be used in the Dymond formulation

while Applicants have shown tests with only one. For example, the Examiner named acrylamide and carboxymethyl cellulose as alternative fluid loss control agents not included in Applicants' data, even though these agents would more commonly be used with water based fluids than with oil or emulsion based fluids. The Examiner has not refuted that the fluid loss control agent Applicants used in their test was a common fluid loss control agent used in oil and emulsion based fluids. Rather, the Examiner reiterated in interview that many fluid loss control agents could be used. However, Applicants respectfully request that the Examiner reconsider his rejections because the Examiner has not shown that Dymond makes this teaching nor has he shown the general knowledge in the art and/or common practice on which he is basing his rejections. MPEP § 2144.03(A) provides that, "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are capable of instant and unquestionable demonstration as being well-known."

Further, even if many different fluid loss control agents could be used as the Examiner states, and even if *arguendo* as the Examiner further implies some of the fluid loss control agents would cause the Dymond drilling fluid to yield different results than the results shown in Applicants' test, in any case such conjecture does not support a position that Dymond anticipates Applicants' drilling fluid without any fluid loss control agent as Applicants claim in amended independent claims 1, 14 and 27. The Examiner commented in interview (see interview summary previously filed) that the Dymond reference did not say that a fluid loss control agent had to be used. Applicants respectfully traverse this assertion because the Dymond reference used a fluid loss control agent in every example drilling fluid formulation provided and included no

teaching that a fluid loss control agent could be omitted from the drilling fluid formulation taught. See MPEP § 2144.03(A), citing among other cases, *In re Eynde*, 480 F.2d 1364, 1370, 178 U.S.P.Q. 470, 474 (CCPA 1973), noting that the court rejected “the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.” Rather than the Examiner’s conclusion that Dymond enables a drilling fluid without a fluid loss control agent, Applicants respectfully submit that it seems more logical and reasonable to infer that Dymond’s teaching of a drilling fluid composition would set out the least number of components thought necessary to accomplish the desired objective of a drilling fluid. Thus, one skilled in the art who would read the Dymond teaching would have to presume that, if the components were not combined as shown, some inferior or useless product would occur. *In re Freed*, 425 F.2d 785, 165 U.S.P.Q. 570, 572 (C.C.P.A. 1970). “When omitting steps would run counter to the teaching of the reference patent relied upon, the patentability of a process with fewer steps is not precluded by 35 U.S.C. § 103.” *Ex part Kaiser*, 189 U.S.P.Q. 816 (PTO Bd. App. 1974).

Applicants respectfully submit that Dymond does not have the necessary elements for anticipation and does not give the public the benefit of Applicants’ invention.

#### **VII. Rejection of Claims under 35 U.S.C. §102 or alternatively 35 U.S.C. § 103**

The Examiner has again rejected claims 1,6-8, 13-15, 21, 23, 24, 26, and 27 under 35 U.S.C. 102(b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious from, Dymond (4777200). Specifically, the Examiner has stated:

Dymond teaches a drilling fluid within the scope of the present invention, used in drilling a subterranean formation (see the examples). Although Dymond

does not specifically show an example of a drilling fluid without a fluid loss agent, the specification therein does not teach that one is necessary. The specification is clearly enabling of a drilling fluid without a fluid loss agent. The courts have held that inherent anticipation only requires an enabling disclosure, and not an actual reduction to practice (*Smithkline Bechman v. Apotex* 74 USPQ2d 1398). Thus from the teaching of Dymond, such fluids inherently having the properties of the current invention would be enabled to one of ordinary skill in the art. To the extent that one could remotely argue that Dymond does not anticipate, it is well established that removing an ingredient or method step and its intended function is obvious to one of ordinary skill in the art. (*In re Karlson* 136 USPQ 184, *In re Brown* 108 USPQ 232). The removal of the fluid loss agent, is thus obvious to one of ordinary skill in the art, since the remaining fluid would still have utility as a drilling fluid.

Applicants respectfully traverse the Examiner's rejections for the reasons stated above with respect to traversing the Examiner's rejection of claim 28 and for the further reasons discussed below.

Applicants respectfully traverse the form of the Examiner's alternative rejections. Inherency and obviousness are distinct concepts and pose entirely different questions. As the Federal Circuit has stated: "The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency.] [citations omitted] That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown. [citation omitted] Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. [citation omitted]" *In re Rijckaert*, 9 F.3d 1531, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

Applicants respectfully submit that the Dymond reference provides no teaching or suggestion of a synthetic invert emulsion drilling fluid with the minimal elements claimed by Applicants and no teaching or suggestion of the effectiveness of a drilling fluid with the minimal elements claimed by Applicants.

Since Dymond teaches multiple uses of the fluid therein, and always includes elements in the Dymond drilling fluid not required in Applicants' fluid, Applicants respectfully submit that Dymond is not an enabling disclosure of Applicants' fluid and methods. Dymond also fails to teach the synthetic invert emulsion base for the fluid taught by Applicants, further indicating that Dymond is not an enabling disclosure of Applicants' fluid and methods.

Applicants respectfully submit that the Examiner's reliance on In re Karlson, 136 U.S.P.Q. 184 (1962) and In re Brown, 108 U.S.P.Q. 232 (1955) for the principle that "removing an ingredient or method step and its intended function is obvious to one of ordinary skill in the art" is misplaced, as these cases and this principle fail to support the Examiner's position in rejecting Applicants' claims. Applicants respectfully submit that while they have removed ingredients and method steps from the prior art, the function of the removed ingredients or removed steps has not been removed. Applicants specifically teach an advantage of their invention over the prior art in that their drilling fluid functions efficiently and effectively as a drilling fluid with fewer components than prior art fluids. See Applicants' specification at paragraphs [0008], [0015], [0024]. Applicants' invention does not require the addition of fluid loss control agents, viscosifiers, or suspension agents to achieve desirable and even superior, fluid rheology over a broad temperature range. Dymond on the other hand includes fluid loss control agents in every drilling fluid example, and even then does not teach utility over the broad temperature range taught by Applicants. Moreover, Applicants' have demonstrated with laboratory testing described in their specification that the Dymond fluid does not achieve the advantages of Applicants' invention.

Rather, it has been said that a machine or article that is made with fewer parts or fewer components than the prior art, but which accomplishes all of the functions of the prior art, as does Applicants' invention, "is the type of improvement which merits a patent." Deering Milliken Research Corp. v. Beaunit Corp., 382 F. Supp. 403, 182 U.S.P.Q. 421, 425 (N.C. 1974), reversed on other grounds, 538 F.2d 1022, 189 U.S.P.Q., 565 (4<sup>th</sup> Cir. 1976). Although the Examiner has argued that Dymond is enabling for purposes of anticipating Applicants' invention, Applicants respectfully submit that no evidence has been submitted to support the Examiner's conclusion. As noted above, it seems more logical and reasonable to infer that Dymond would use the least number of components thought necessary to formulate a drilling fluid. One skilled in the art who would read the Dymond teaching would presume that, if the components were not combined as shown, some inferior or useless product would result. In re Freed, 425 F.2d 785, 165 U.S.P.Q. 570, 572 (C.C.P.A. 1970). Applicants submit that Dymond reflects the teachings and recognition of the art – that a fluid loss control agent would be needed in a drilling fluid having the other components listed. If it were so obvious to formulate a drilling fluid without a fluid loss control agent, then it would have been obvious as well to Dymond and Dymond would have at least suggested such possibility. Yet, Dymond does not. Id.

Applicants respectfully request that the Examiner reconsider his rejections.

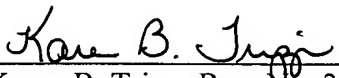
### SUMMARY

Applicants have filed a request for continued examination to allow the Examiner to reconsider the claims as further amended herein.

Applicants respectfully submit that all of the pending claims, as amended, are in condition for allowance and Applicants respectfully request the Examiner to enter the amendments and to allow the application to proceed to issue.

Respectfully submitted,

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